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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,587	08/07/2000	Geoffrey B. Rhoads	60258	3357

23735 7590 03/15/2004

DIGIMARC CORPORATION
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EXAMINER

BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/15/2004 9

Please find below and/or attached an Office communication concerning this application or proceeding.

P24

Office Action Summary

Application No.

09/633,587

Applicant(s)

RHOADS ET AL.

Examiner

Barbara N Burgess

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

This Office Action is in response to amendments filed December 22, 2003. Claims 1-25 are presented for further consideration.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9, 11, 18-21, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube in view of Schena et al. (hereinafter "Schena", US 2001/0001854 A1).

As per claim 1, Hube discloses a document management method comprising:

- Presenting a paper sheet to an optical sensor, the sensor producing scan data comprising document image data, the paper sheet having an optically-detectable indicia thereon, the indicia being machine readable but not generally intelligible to a human viewer thereof (column 2, lines 27-28, 37-40, 42043, 49-54, 56-60, column 3, lines 16-18, 25-31, 41-43, column 4, lines 14-16, 33-35, 57-65);
- Processing the document image data to decode binary identification data represented by said indicia (column 2, lines 27-28, 37-40, 42043, 49-54, 56-60, column 3, lines 16-18, 25-31, 41-43, column 4, lines 14-16, 33-35, 57-65).

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Hube does not explicitly disclose:

- Storing said document image data in a data store, wherein the document image data can thereafter be accessed from the data store by use of said binary identification data;
- Wherein a single scan of said paper sheet permits acquisition of both an image of the sheet for archiving, and identification data by which the stored image data can later be recalled.

However, in an analogous art Schena discloses a system for back-up electronic data in the form of machine-readable code wherein the scanners scans the printed data and reads the machine-readable code to access the document (paragraphs [0006], [0008], [0013], [0016]-[0018], [0030], [0032]-[0033], [0041]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate storing image data in a data store and wherein a single scan permits acquisition of both image and identification data in Hube's system in order to present a back-up copy of the document.

As per claims 2 and 18, Hube discloses the method of claim 1 wherein the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof (column 2, lines 27-28, 37-40, 42-43, 49-54, 56-60, column 3, lines 16-18, 25-31, 41-43, column 4, lines 14-16, 33-35, 57-65).

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As per claims 3 and 19, Hube discloses the method of claim 2 wherein the adhesive note is a Post-It brand note (column 5, lines 1-5).

As per claims 4-7, Hube does not explicitly disclose:

- Using identification data to access the data store.

However, the use and advantages of displaying data on a computer screen is well known to one of ordinary skill in the art as evidenced by Phillips (Abstract, column 1, lines 14-20).

However, in an analogous art Schena discloses a system for back-up electronic data in the form of machine-readable code wherein the scanners scans the printed data and reads the machine-readable code to access the document (paragraphs [0006], [0008], [0013], [0016]-[0018], [0030], [0032]-[0033], [0041]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using the identification to access the data store in Hube's system in order to present a back-up copy of the document.

As per claims 9 and 20, Hube does not explicitly disclose the method of claim 1 wherein the indicia comprises a steganographic watermark. However, the use and advantages of using a watermark is well known to one of ordinary skill in the art as evidenced by Schena (paragraph [0032], [0045]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the use of a watermark in Hube's

system in order for copyrighted materials to carry article identifying information and distribution information.

As per claim 11, Hube discloses the method of claim 1 wherein the optical sensor comprises an array of plural photosensor elements (column 3, lines 49-64, column 5, lines 39-52).

As per claim 21, Hube discloses a sheet according to claim 18 wherein the indicia is a bar code (column 4, lines 57-67).

As per claim 25, Hube discloses a sheet according to claim 18 wherein the indicia is formed by texturing (column 4, lines 57-67).

3. Claims 8, 12, 15-16, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube in view of Schena et al. (hereinafter "Schena", US 2001/0001854 A1) in further view of Zhang et al. (hereinafter "Zhang", 6,325,420 B1).

As per claims 8 and 22, Hube, in view of Schena, does not explicitly disclose the method of claim 1 wherein the identification data represented by the indicia comprises between 20 and 64 bits of binary information. However, the use and advantages of using binary information is well known to one of ordinary skill in the art as evidenced by Zhang (column 2, lines 64-67).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using binary information that comprises between 20 and 64 bits in Hube's, in view of Schena, system in order to minimize the visual impact of the print control symbol.

As per claims 12, 15-16, 17, Hube, in view of Schena, does not explicitly disclose a method comprising:

- Displaying on a computer screen document data associated with binary data.

However, the use and advantages of displaying data associated with binary data is well known to one of ordinary skill in the art as evidenced by Zhang (Figure 5, column 7).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate displaying on a computer screen document data associated with binary data in Hube's system in order to view scanned data.

As per claims 13, Hube further discloses wherein the adhesive note is a Post-It brand note (column 5, lines 1-5).

As per claim 14, Hube discloses in which said document data comprises a document image (column 2, lines 27-28, 37-40, 42-43, 49-54, 56-60, column 3, lines 16-18, 25-31, 41-43, column 4, lines 14-16, 33-35, 57-65).

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4. Claims 10, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube in view of Schena et al. (hereinafter "Schena", US 2001/0001854 A1) in further view of Reber et al. (hereinafter "Reber", 6,081,827).

As per claims 10, 23-24, Hube, in view of Schena, does not explicitly disclose the method of claim 1 wherein the indicia is formed on said sheet by ink jet printing. However, the use and advantages of using ink-jet printing is well known to one of ordinary skill in the art as evidenced by Reber (column 4, lines 61-67).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the use of ink-jet printing in Hube's system in order for data to be read by both optical readers and magnetic readers.

Response to Arguments

The Office notes the following arguments:

- (a) The reference does not appear to concern documents bearing indicia that is "machine-readable but not to generally intelligible to a human viewer thereof."
- (b) Mano does not teach an arrangement in which "the document image data can thereafter be accessed from the data store by use of said binary identification data."
- (c) Mano does not teach a steganographic watermark.
- (d) Mano does not teach ink jet printing.

In response to:

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(a)-(d) Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

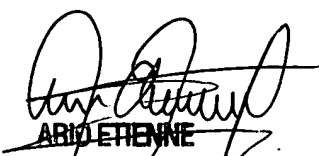
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Ettinene can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess
Examiner
Art Unit 2157


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100